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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,360	10/29/2003	Martin Frank	ROCHE-P0019	6700

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BAKER & DANIELS LLP / ROCHE
300 NORTH MERIDIAN STREET
SUITE 2700
INDIANAPOLIS, IN 46204

EXAMINER

LEVKOVICH, NATALIA A

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,360

Applicant(s)

FRANK ET AL.

Examiner

Natalia Levkovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 38-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-34 and 38-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

1. This Office Action replaces the action mailed on 07/06/2007, which contained defects caused by claim having been misnumbered due to a typographic error. The instant action sets a new statutory time period for response.
2. Upon further consideration, the following restriction to one of the inventions, listed below, applies under 35 U.S.C. 121:
 - I. Claims 1-10 and 21-34, drawn to a test element analysis system comprising an evaluation instrument which includes a storage container and a sample application position;
 - II. Claims 11-20, drawn to a test element analysis system comprising a storage container arranged outside of an evaluation instrument which includes a test element holder and test elements with frames having rims and diameters increasing from the rims in two 'directions running vertical to the test filed plane';
 - III. Claims 38-43, drawn to a storage container accommodating test elements with a frame.
3. Inventions I and II are related, but independent and distinct, each from the other. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually

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exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the analysis systems, as claimed, are not obvious variants, they have a materially different design and are not disclosed to be used together.

4. Inventions I, II and III are related as combination and subcombination.

Since the analysis systems, as recited in claims 1 and 11, require the particulars of the storage container, as it is recited in claim 38, the claims of invention III will be considered together with the elected claims directed to the analysis system.

5. Note that either of the inventions I or II, when elected, is subject to further restriction, since it contains claims directed to the following patentably distinct species of the analysis system:

Species I, drawn to a test element analysis system comprising a gripping fork with the distance between the arms of the fork decreasing towards the front end of the gripping section;

Species II, drawn to a test element analysis system comprising a gripping fork configured for a 'one-dimensional translatory motion';

Species II, drawn to a test element analysis system comprising a gripping fork configured for a 'swiveling movement' around a fixed axis which 'runs vertical to the test field plane';

Additionally, in case invention I is elected, it is subject to further restriction, since it contains claims directed to the following patentably distinct species of the test elements:

Species 1, drawn to a test element comprising a frame with 'surface area at the sample application side of the test element' being 'at most three times as large as the area of: the sample application surface of the test field' ;

Species 2, drawn to a test element comprising a frame with the diameter increasing from the gripping rim in a 'spatial direction vertical to the test field plane, forming a protruding shoulder';

Species 3, drawn to a test element comprising a frame which surrounds a reception trough for receiving the test field, with the depth of the reception trough being larger than the thickness of the test field., so that the 'circumferential limiting wall of the reception trough extends beyond the surface of a test field received thereby'

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system; see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700